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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,351	09/12/2003	Peter Ellington	MRKS/0126	1597

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WILLIAM B. PATTERSON  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
Suite 1500  
3040 Post Oak Blvd.  
Houston, TX 77056

EXAMINER

PATEL, VISHAL A

ART UNIT PAPER NUMBER

3679

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,351

Applicant(s)

ELLINGTON ET AL.

Examiner

Vishal Patel

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8, 11-14, 17 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 11-14, 17 and 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/20/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-5, 8, 11, 24-28 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 4,113,290 to Miida.

See male threaded pin member 3 and female threaded pin member 2 as shown in fig. 4 wherein some flanks are engaged and some flanks are gapped. It is noted that the Miida coupling is not stated to be expanded however it is the examiner's position that it is clearly expandable' as claimed. The examiner finds no distinction, and applicant has provided no distinction, between a threaded connection and one that is to be expanded or is expandable. Such matters are considered to be a matter of intended use in the product claims and as such do not patentably define over the prior art. As to claim 11 see column 3, lines 55-60. As seen in Miida the flanks that contact each other are located in a central region (in section II as seen in figure 4).

3. Claims 2-5, 8, 11-14, 17, 21, 23-28 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,158,785 to Beaulier et al.

See male threaded pin member 30 and female threaded pin member 130 as shown in fig. 12 wherein some flanks are engaged and some flanks are gapped. It is noted that the Beaulier et al. coupling is not stated to be expanded however it is the examiner's position that it is clearly expandable as claimed. The examiner finds no distinction, and applicant has provided no

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distinction, between a threaded connection and one that is to be expanded or is expandable. Such matters are considered to be a matter of intended use in the product claims and as such do not patentably define over the prior art. As to claims 17 and 18 see claim 7 of Beaulier et al.. As to claims 23 and 24 see column 7, lines 1-5. The flanks that contact each other are located in a central region (as seen in figures 12 or 16).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6,7,20 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,1 13,290 to Miida in view of WIPO patent WO02/01 102 and applicant's admitted prior art in the specification on pages 1-2.

As noted above the Miida coupling discloses the claimed device except the threaded connection is not expanded. The WPO coupling and applicant's disclosure of prior art on pages 1-2 of the specification discloses that it is known in the art to expand threaded pipes or casing joints for various reasons using either rotary expansion tools, solid cone expansion tools or hydraulic expansion tools. It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the threaded coupling of Miida as needed as taught by the WIPO patent and applicant's disclosure on pages 1-2 of the specification in order to provide a more secure coupling for the threaded coupling to reinforce worn casing or reduce the required diameter of the drilled hole for a final casing hole diameter.

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6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miida as applied to claim 2 above, and further in view of Evans (US. 6,893,057).

Miida discloses the invention substantially as claimed above but fails to disclose that the thread is a square thread. Evans teaches to have a square thread or dovetail thread or etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the thread of Miida to be a square thread as taught by Evans, since have a square thread or dovetail thread or other type of thread is considered to be art equivalent.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beaulier as applied to claim 2 above, and further in view of Evans.

Beaulier discloses the invention substantially as claimed above but fails to disclose that the thread is a square thread. Evans teaches to have a square thread or dovetail thread. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the thread of Beaulier to be a square thread as taught by Evans, since have a square thread or dovetail thread is considered to be art equivalent.

### ***Response to Arguments***

8. Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive.

Applicants' argument that Miida does not illustrate abutting flanks and gap between the remaining flanks is not persuasive because as noted above that Miida teaches that the flanks of the thread in section II are in contact and flanks of the thread in section III are not in contact.

Applicants' argument that Beaulier does not illustrate abutting flanks and gap between the remaining flanks is not persuasive because as noted above that Beaulier illustrates in figures

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12 or 16 that the flanks of the thread are in contact in a central region and the other remaining flanks of the thread provide a gap therebetween.

Applicants' argument that neither Miida nor Beaulier illustrate differential expansion is not persuasive because as seen in Miida that the gap between the flanks are sized different, hence providing differential expansion when the coupling is expanded. This is also true for Beaulier as illustrated in figure 14.

Applicants' argument that WO02/01102 does not provide a reason to combine is not persuasive because as pointed out above that to expand a member that is threaded is to eliminate gaps between thread flanks to provide a secured connection of two members.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

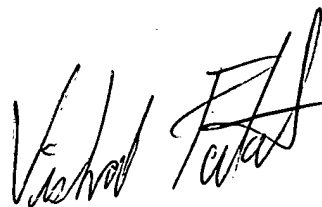
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP  
August 2, 2005

A handwritten signature in black ink, appearing to read 'Vishal Patel', is written over a horizontal line.

Vishal Patel  
Patent Examiner  
Tech. Center 3600